

REMARKS

The new and amended claims introduce no new matter.

Restriction requirement

5 At paragraphs 3 and 4, the Office indicated that the scope of the compounds to be included in the restriction would include compounds where neither R⁸ nor R⁹ included -O- or -NH- as Applicants had previously proposed. Applicants traverse the restriction. The Office indicated that Applicant's proposed compound scope would impose an undue search burden on the Office.

10 Applicants respectfully disagree, since chemical search engines typically allow inclusion of heteroatoms at selected positions in heterocyclic compounds. Applicants thus do not believe that the inclusion of two heteroatoms at two positions (R⁸ and R⁹) would impose an undue search burden on the Office. Applicants request reconsideration of the restriction as it currently stands.

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Double patenting

At paragraphs 6, 7 and 8, the Office provisionally rejected claims 50, 57, 61 and 62 as unpatentable over claims 20-22 of copending application No. 10/607,415, claims 50, 55, 57, 59, 61, 62, 64 and 66 as unpatentable over claims 20 30-33 of copending application No. 10/728,400 and claims 50, 57, 61, 62 and 66 as unpatentable over claims 19-21 of copending application No. 10/949,694. Applicants request the Office to hold these provisional rejections in abeyance until patentable subject matter is identified in either this application or in at least one of the cited copending applications.

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35 U.S.C. § 102(b)

At paragraphs 9 and 10, the Office rejected claims 50 and 57 as anticipated by Daynes et al. (U.S. patent No. 5,532,230, the " '230" patent). Applicants respectfully traverse the rejection.

30 Review of the '230 patent shows that none of the compounds the '230 patent describes is a species within the scope of the compounds that amended claim 50 recites. The '230 patent describes compounds such as

dehydroepiandrosterone (col. 14, line 53), 16 α -bromodehydroepiandrosterone (col. 14, line 54), androstenediol (col. 14, line 55), androstenedione (col. 13, line 24), 16 α -hydroxydehydroepiandrosterone (col. 14, line 6) and 16 α -chlorodehydroepiandrosterone (col. 14, line 8). None of these compounds
5 anticipate any of the compounds within the scope of compounds that amended claim 50 recites.

The clinical conditions described in the '230 patent are associated with trauma, ischemia and reperfusion injury. Specific clinical conditions the '230 patent discusses include adult respiratory distress syndrome, bacterial
10 translocation, infarction, thermal burns and traumatic injuries. None of the clinical conditions the '230 patent describes includes any of the clinical conditions that claim 57 recites. Because of this, the '230 patent cannot anticipate claim 57.

In view of the foregoing, Applicants respectfully request reconsideration and withdrawal of the rejection.

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35 U.S.C. § 103(a)

At paragraphs 11 and 12, the Office rejected claims 50, 55, 57 and 59 as allegedly obvious in view of the '230 patent discussed above. Applicants respectfully traverse the rejection. At col. 15, lines 8-25, the '230 patent indicates
20 that active compounds such as dehydroepiandrosterone (DHEA) contain a ketone moiety at the 17-position. The amended claims do not recite a ketone at the 17-position and thus are not obvious in view of '230.

Also, the '230 patent discloses the use of compounds for treating acute clinical conditions such as trauma, burns and infarctions by administering the
25 compounds within a few hours of an acute injury, see, e.g., col. 8, lines 13-19. Clinical conditions that claim 57 and the claims that depend on claim 57 recite the presence of a chronic condition such as asthma. The '230 patent thus teaches that some compounds may be used in some acute clinical conditions if the compounds are administered immediately. This scenario would thus not be
30 expected to apply to their use in treating chronic conditions.

In view of the foregoing, Applicants respectfully request reconsideration and withdrawal of the rejection.

Conclusion

5 Applicants request entry of the amendments and reconsideration of the rejections. Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 501536.

Respectfully submitted,

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